

123,506
Consolidated
parent

TIA3

03-18-2003

U.S. Patent & TMO/TM Mail Rpt Dt. #71

BEFORE THE
UNITED STATES PATENT & TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD

PUCCEL ENTERPRISES, INC.
Petitioner,

CONSOLIDATED

v.

GRIZZLY INDUSTRIAL, INC.
Respondent.

Opposition No. 123,506 Mark: GRIZZLY.COM
Application Serial No. 76/088,346
Cancellation No. 31,984 Mark: GRIZZLY
Cancellation No. 32,024 Mark: GRIZZLY
Registration No. 2,413,625
Cancellation No. 32,025 Mark: GRIZZLY INDUSTRIAL

RESPONDENT'S/APPLICANT'S MOTION
TO AMEND CERTIFICATE OF REGISTRATION NO. 2,413,625
AND APPLICATION SERIAL NO. 76/088,346
PURSUANT TO SECTION 7(H) OF THE LANHAM ACT

Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Dear Sirs:

[X] AUTHORIZATION TO PAY AND PETITION FOR THE ACCEPTANCE OF ANY NECESSARY FEES: If any charges or fees must be paid in connection with the following Communication (including but not limited to the payment of issue fees), they may be paid out of our deposit account No. 50-1965. If this payment also requires a Petition, please construe this authorization to pay as the necessary Petition which is required to accompany the payment.

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first-class mail in an envelope addressed to: Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202 on:

Date: March 14, 2003
Signature: Robbi Shew
Robbi Shew

MICHAEL BEST & FRIEDRICH LLC
401 North Michigan Avenue, Suite 1900
Chicago, Illinois 60611-4212
(312) 661-2100
Fax: (312) 222-0818

DD

Registrant/Applicant, Grizzly Industrial, Inc. ("Grizzly"), hereby moves pursuant to Section 7(h) of the Lanham Act that Registration No. 2,413,625 (GRIZZLY) and Application Ser. No. 76/088,346 (GRIZZLY.COM) be amended in accordance with the attached Exhibits 1 and 2, respectively. 37 CFR 2.133(a). The registration and application are currently the subject of the above-captioned consolidated proceeding.

The Amendments (Exhibits 1 and 2) delete certain goods and services and limit the channels of trade. To assist the Board or Trademark Examiner in identifying the proposed changes, the format is as follows: the bolded, underlined text represents proposed additions, and the text that is struck represents proposed deletions.

Specifically, in Appl. Ser. No. 76/088,346 (GRIZZLY.COM), Grizzly seeks to narrow the description of the services so that the beginning of the description of the claimed services reads:

Retail store services, online retail store services, and mail order services featuring **products for woodworking and metal working, namely services featuring:**...

(Emphasis to show the changes). Grizzly also seeks to delete from this application "services featuring dollies, hand trucks, storage bins, tool tables, sliding tables, and material handling equipment, namely, carts, casters and wheels, mobile bases, outfeed tables and stands, roller stands, rollers, tables, and work stands."

Similarly, in Reg. No. 2,413,625 (GRIZZLY), Grizzly seeks to narrow the description of services offered in IC 035 to refer to "mail order services **for products for woodworking and metal working, namely, services** featuring ...". The description of goods in IC 008 has similarly been limited to "**woodworking and metal working** hand tools, namely ...". The description of goods in IC 009 is now limited to "**Woodworking and metal working** measuring

equipment, namely, dial indicators, dial calibrators, digital calipers and instruments, and measuring tapes; software, namely, software for disseminating information related to wood and metal working and wood and metal working equipment through a global information network; magnetic switches.”

Thus, the amendments narrow, and do not broaden, the identification of goods and services. No re-publication or re-searching will be necessary. In view of this, Grizzly submits that the proposed amendment complies with all applicable rules and statutory provisions. TBMP § 514.01.

The amendments proposed by Grizzly narrow the channels of trade to more accurately reflect Grizzly’s woodworking and metal working consumers and, as a result, eliminates any perceived overlap with the goods identified by Pucel Enterprises, Inc. (the petitioner/requester in the consolidated proceeding) in its asserted registrations. Despite this, Pucel refused to consent to this amendment in a teleconference with Grizzly’s counsel on March 13, 2003.

Petitioner, Pucel Enterprises, Inc., has not consented to this request. Because this request is made well prior to trial, Pucel has received fair notice thereof. TBMP 514.03. Moreover, since the discovery period is still open, Pucel has an opportunity to take discovery on this matter and, therefore, is not prejudiced by this Amendment.

For the foregoing reasons, Grizzly requests that its motion be allowed.

Respectfully submitted,



Joseph F. Schmidt

Lisa C. Childs

MICHAEL BEST & FRIEDRICH LLC

401 North Michigan Avenue, Suite 1900

Chicago, IL 60611

(312) 661-2100

(312) 222-0818 (fax)

Attorneys for Grizzly Industrial, Inc.

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing
**RESPONDENT'S/APPLICANT'S MOTION TO AMEND CERTIFICATE OF
REGISTRATION NO. 2,413,625 AND APPLICATION SERIAL NO. 76/088,346
PURSUANT TO SECTION 7(H) OF THE LANHAM ACT** was served on Petitioner/Opposer
at the following address:

Kenneth L. Mitchell
Woodling, Krost and Rust
Kirtland Office Complex
9213 Chillicothe Road
Kirtland, OH 44094

via first class mail, postage prepaid, March 14, 2003



Attorney for Respondent/Registrant

**BEFORE THE
UNITED STATES PATENT & TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD**

PUCEL ENTERPRISES, INC.
Petitioner,

CONSOLIDATED

v.

GRIZZLY INDUSTRIAL, INC.
Respondent.

Opposition No. 123,506 Mark: GRIZZLY.COM
Application Serial No. 76/088,346
Cancellation No. 31,984 Mark: GRIZZLY

Cancellation No. 32,024 Mark: GRIZZLY
Registration No. 2,413,625
Cancellation No. 32,025 Mark: GRIZZLY INDUSTRIAL

Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Dear Sirs:

[X] AUTHORIZATION TO PAY AND PETITION FOR THE ACCEPTANCE OF ANY NECESSARY FEES: If any charges or fees must be paid in connection with the following Communication (including but not limited to the payment of issue fees), they may be paid out of our deposit account No. 50-1965. If this payment also requires a Petition, please construe this authorization to pay as the necessary Petition which is required to accompany the payment.

AMENDMENT TO REGISTRATION NO. 2,413,625 (GRIZZLY)

Registrant seeks to amend the identification of goods and recitation of services in its registration as follows, in which the bolded, underlined text are additions.

IC 035. G & S: Mail order services **for products for woodworking and metal working, namely, services** featuring abrasives, jigs, air cleaners, air compressors, air compressor accessories, anti-fatigue mats, aprons, back support belts, meat cutting bandsaws, metal cutting bandsaws, wood bandsaws, bandsaw accessories, biscuits, bit systems, blade cleaners, blade stabilizers, books, brad drivers, brad point bit sets, buffing compounds, buffing systems, buffing wheels, carbon paper, center finders, chisels, band clamps, bar clamps, C-clamps, T-clamps, hold-down clamps, pipe clamps, saddle clamps, specialty clamps, cleaners, combination squares, compressors, contact cement contour gauges, countersink sets, dado blades, dead blow hammers, depth stops, dovetail jigs, dowel plugs, doweling jigs, drafting boards, drawer slides, drill bits

EXHIBIT 1

and guides, drill presses, drill press accessories, drill sharpeners, dust collectors, dust collection accessories, electric motors, emery clothes, face frame jigs, face plates, featherboards, files, glues, glue brushes, bench grinders, flex shaft grinders, mini grinders, portable grinders, slow speed grinders, universal knife grinders, wide wheel grinders, grinding stands, grinding stones, grinding wheels, hack saw kits, handscrews, hinges, hole restorer tools, hose reels, hollow chisel mortisers, jigs and fixtures, jointers, jointer clamp systems, knee pads, knife-setting jigs, wood lathes, metal lathes, wood lathe accessories, lathe chucks, levels, lubricants, magnetic switches, magnetizers and demagnetizers, mallets, marking gauges, measuring tools, miter boxes, miter saw work stations, miter trimmers, mobile bases, moisture meters, mortising attachments, moulding heads and knives, multi-spur bits, nail guns and nails, nail pullers, paint and stain kits, paint brushes, paint sprayers - HVLP, plans, planers, planer knives, planer/moulders, planer pals, plug cutters, pneumatic tools, power carvers, power feeders, power tools, pressure washers, push blocks, push sticks, rasps, rasp sets, remote controllers, right angle drives, roller stands, rosette cutterheads and cutters, router bits, router bit sets, router pads, router speed controls, router tables, router table accessories, rub collars, rub bushings, rub spacers, rubber gloves, rust removers, safety equipment, sandblasters, belt sanders, bench sanders, combination sanders, disc sanders, drum sanders, edge sanders, knife belt sanders, spindle sanders, sanding accessories, sanding belts, sanding discs, sanding drums, sanding rolls, sanding sleeves, sanding wheels, saw blades, bandsaw saw blades, circular saw blades, scroll saw blades, saw horse brackets, saw horses, scaffolding, scrapers, screws, screw accessories, scroll saws, shapers, shaper cutters, sharpening accessories, shop vacuums, snips, spokeshaves, spray guns, staplers, steel squares, step drills, stop blocks, table saws, table saw accessories, table saw inserts, table saw fences, tack cloth, tenon cutters, thickness gauge, toggle clamps, tool organizers, Trammel points, V- belts, varnishes, vise clamps, vises, wood parts, wood threading kits, and woodworking accessories, ordered from printed and on-line catalogs.

IC 007. G & S: Wood and metal working shop machinery, namely, air cleaners, air compressors and accessories for air compressors, meat cutting bandsaws, metal cutting bandsaws, wood bandsaws, buffing machines and buffing wheels for metal working, drill presses and accessories for drill presses, dust collectors and accessories for dust collectors, face plates for lathes bench grinders, flex shaft grinders, mini grinders, portable grinders, slow speed grinders, universal knife grinders, wide wheel grinders, grinding stands, wood lathes and accessories for wood lathes, lathe chucks, metal lathes and tooling for metal lathes, mortising machines, mortising attachments for drill presses, nail guns, planer knives, belt sanders, bench sanders, combination sanders, disc sanders, drum sanders, edge sanders, knife belt sanders, spindle sanders, sanders and accessories for sanders, sanding belts, sanding discs, sanding drums, sanding rolls, sanding sleeves, sanding wheels, saw blades for power operated saws, bandsaw saw blades, circular saw blades, scroll saw blades, shaper cutters, shop vacuums, steel squares for machines, table saws and accessories for table saws, milling machines, milling vises for milling machines, rotary tables and angle plates for milling machines, sheet metal machines for bending, cutting, notching, slip rolling, and punching flat and tubular sheet metal, sand blasting machines, welding machines, radial drills, and electric and battery operated power tools.

EXHIBIT 1

IC 008. G & S: Woodworking and metal working hand tools, namely, hammers, screwdrivers, chisels, wood carving knives, pliers, scrapers, hand saws, nail pullers, sanding blocks, saw blades, saw horses, socket sets, wrenches, anvils, tap and die sets.

IC 009. G & S: Woodworking and metal working measuring equipment, namely, dial indicators, dial calibrators, digital calipers and instruments, and measuring tapes; software, namely, software for disseminating information related to wood and metal working and wood and metal working equipment through a global information network; magnetic switches.

EXHIBIT 1

**BEFORE THE
UNITED STATES PATENT & TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD**

PUCEL ENTERPRISES, INC.
Petitioner,

CONSOLIDATED

v.

GRIZZLY INDUSTRIAL, INC.
Respondent.

Opposition No. 123,506 Mark: GRIZZLY.COM

Application Serial No. 76/088,346

Cancellation No. 31,984 Mark: GRIZZLY

Cancellation No. 32,024 Mark: GRIZZLY

Registration No. 2,413,625

Cancellation No. 32,025 Mark: GRIZZLY INDUSTRIAL

Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Dear Sirs:

[X] AUTHORIZATION TO PAY AND PETITION FOR THE ACCEPTANCE OF ANY NECESSARY FEES: If any charges or fees must be paid in connection with the following Communication (including but not limited to the payment of issue fees), they may be paid out of our deposit account No. 50-1965. If this payment also requires a Petition, please construe this authorization to pay as the necessary Petition which is required to accompany the payment.

AMENDMENT TO SER. NO. 76/088,346 (GRIZZLY.COM)

Registrant seeks to amend the recitation of services in its application as follows, in which the bolded, underlined text are additions, and the text that is struck represents deletions.

IC 035. G & S: Retail store services, online retail store services, and mail order services featuring **products for woodworking and metal working, namely services featuring:** abrasives; air cleaners; air compressors; air tanks; air tools; angle finders; anti-kickback devices; anti-vibration mounts; auger bits; bearings; belts; benders; bevels; blade stabilizers; bolt cutters; books and plans; buffing compounds; buffing machines; buffing wheels; burrs; cable ties; calipers; cement; center punches; chain hoists; chisels; chucks; clamps and vises; clamp heads; containers; cordless tools; cut-off wheels; cutters; dial indicators; dies; digital read outs; discs;

EXHIBIT 2

~~dollies~~; dowel cutting saws; dowel pins; drafting boards; drill guides; dust collection accessories; dust pans; dust separators; electric motors; end mill holders; end mills; engine stands; feather boards; file card files; filter bags; flexible curves; gauges; gear puller; gloves; gouges; grinders; grinding wheels; hacksaws; hammers; hand cleaner; hand punches; hand screws; ~~hand trucks~~; hex keys; hose reels; hoses; inserts for toolholders; jacks; jig saw blades; jointer knives; knee pads; knobs; laminate trimmer; lathe accessories; live centers; machine mounts; magnetic bases; magnetic shims; magnetic switches; mallets; mandrels; mats; micrometers; miter box; miter trimmer; mortiser machine; moulder/plane; moulding head; moulding head knives; multi-spur bits; nail puller; nailers; nails; notches; planer knives; pliers; protractor; pulleys; punches; push sticks; rasps; ratchet kits; remote controller; router pads; router table; routers; rust remover; safes; sanders; sanding boxes; sanding sealer; sandpaper; saw blades; saw stops; saws; scrapers; screw extractors; screw grabs; screwdrivers; screws; security; shovels; slide tables; slip rolls; sockets; spacers; spindles; sprayers; square; stains; staplers; staples; ~~storage bins~~; switches; tapping machine; tie down ratchets; tile cutters; tin snips. ~~tool tables~~; trammel points; wagons; welding rod; welding supplies; wood filler; wrenches; battery chargers; clothing; generators; levels; parts washers; pressure washers; sandblasters; saw horses; scaffolding; shop vacuums; tool boxes; tool organizers; wheel barrows; cutlery; cutting tools; drill presses; drilling and boring equipment, namely, brad point bits, countersinks, drill bits, extractors, forstner bits, hole saws, plug cutters, quick change bits, reamers, solid carbide bits, spade bits, step drill bits, tapered bits; dust collection systems; fasteners; finishing supplies, namely, brushes, finishes, finishing supplies, spray guns, sprayers; hand tools; hardware, namely, brackets, bumpers, door knockers, drawer pulls, drawer slides, hinges, lock sets, shelf supports; jigs, fixtures; machine accessories, namely, arbors, belt pulleys, blade guides, boring heads, bushings and shapers, chuck inserts, chucks, clamping kits, collet attachments, collets, dividing heads, dust hoods, electric switches; face plates, fences, lathe centers, magnetic chucks, milling attachments, miter gauge, mortising attachments, motors, phase converters, power feed, rails, rotary tables, rub collars, sanding attachments, sleeves, ~~sliding tables~~, spindles, stands, tailstock turrets, tool holders, tool post sets, tool rests, V-belts, V-blocks, wings, ~~material handling equipment, namely, carts, casters and wheels, mobile bases, outfeed tables and stands, roller stands, rollers, tables, work stands~~; measuring tools; metal stock; metalworking machines; pneumatic tools; power tools; router bits; safety equipment, namely, ear protectors, eye protection, first aid kits, gloves, respirators; shaper cutters. shop accessories, namely, anvils, arbor presses, belt cleaners, dowel centers, glue, glue bottles, glue brushes, laminating, lubricants, moisture meters, pads and mats, power bits, push blocks, saw gauges, sharpening equipment, namely, drill sharpeners, sharpening stone sets, stop blocks, tape, tweezers; optical equipment; hand tools; coffee; tooling equipment, namely, boring bars, center drills, countersinks, cut-off and parting, dovetail cutters, end mills, fly cutters, indexable tooling, inserts, key seats, multi-function tools, rotary burrs, slitting saws, taps and dies, tool bits; welding and cutting machines; wood products, namely, biscuits, detail kits, dowels, edge banding, pins, plugs, veneer; and woodworking machines.

EXHIBIT 2